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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,109	09/28/2001	Trevor Vernon Smith	3120.00026	8086

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EXAMINER

LEGESSE, NINI F

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

2C

<b>Office Action Summary</b>	<b>Application No.</b> 09/967,109	<b>Applicant(s)</b> SMITH, TREVOR VERNON	
	<b>Examiner</b> Nini F. Legesse	<b>Art Unit</b> 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 15 July 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>7</u> . | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Applicant's amendment to the specification, claims (1,2,4,7,19,21,27,28) and his proposed drawing correction is acknowledged in paper no. 8. However, the proposed drawing correction will not be entered because the proposed drawing correction have been disapproved since it introduces new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. For example, the original disclosure does not support the showing of an indicator arm passing through the indicator members and going inside a ball.

#### ***Specification***

The disclosure is objected to because of the following informalities:

- On page 15 of the amendment the word "bttl" appear to have no meaning.

Appropriate correction is required.

#### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a) because they fail to show how the position indicator arm is attached to the shoulder pad including the ball and socket joint and the locking means as disclosed on page 3 of the specification.

- A locking means as disclosed in claim 10 is not shown in any of the drawings;
- A ball and socket joint as disclosed in claim 11 is not shown in any of the drawings.

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing

correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 2** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 2 is indefinite because it is not clear as to what structure is encompassed.

This claim does not appear to include any structure.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-7, 9, 12-16, 19 and 20** stand rejected under 35 U.S.C. 102(b) as being anticipated by Cole (US Patent No. 5,919,097).

Cole discloses a golf swing indicator (10) comprising:

- An attachment means (16, 24, 26) for attaching a support member (12) adjacent to a shoulder of a golfer, the support member (12) having shoulder position indicator means/arm (22) projecting outwardly therefrom and forwardly relative to the golfer (Fig. 3) and the golf training aid is used for indicating the shoulder turn during a takeaway in the back swing (column 2, lines 25-34);
- The indicator arm is an elongated member and is substantially perpendicular to the shoulder of the golfer (22, refer to Fig. 1 & 3);
- The indicator arm comprises a resilient member (in column 1, lines 40-43 it is discloses that the device is made of plastic sheet and plastic is a resilient material and also in column 4, line 7 it is disclosed that the arm is a flexible material);
- The shoulder position indicator means (22) is adjustably secured to the support member (since Velcro members 24 and 26 are used to position the indicator means, it can be concluded that the position indicator is adjustable);
- Position retaining means (24,26);
- Indicator member (22);
- The shoulder position indicator means comprises a first indicator member that is supported by the indicator arm (referring to Figs. 1-3, the first indicator member is considered to be the tip of item 22) and a second indicator member located adjacent to the shoulder of the golfer (referring to Fig. 1-3, the second indicator member is considered to be the bottom of item 22)
- A pad (14);

- The support member is located over the forward shoulder of the golfer relative to the swing (Fig. 3); and
- The attachment means comprises a harness mechanism (16).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 8 and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole in view of Lazier (US Patent No. 5,785,603).

Cole fails to disclose a shoulder position indicator with pivotally securing means and a locking means. Lazier discloses a pivotally secured means (Figs. 1-7) and a locking means (66). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a pivotally secured support member with a locking means as disclosed by Lazier in the Cole device in order to secure the shoulder position indicator to any position.

**Claim 11, 27 and 28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole in view of Stawicki (US Patent No. 5,150,901).

Cole fails to disclose a ball and socket joint, an indicator means that can be moved in at least two planes wherein said at least two planes are perpendicular to each other.

Stawicki discloses a ball (44) and socket (46) joint that can be moved in at least two

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planes wherein said at least two planes are perpendicular to each other (for example refer to Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a ball and socket joint as taught by Stawicki in the Cole device in order to practice the correct swing for striking a golf ball for any particular golf shot.

**Claim 17 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole in view of Stawicki and Pritchard et al. (US Patent No. 3,883,053). Cole discloses a pad (14) but fails to disclose a shoulder pad because his device is to be attached to the upper part of an arm. He also does not explicitly teach that the pad is flexible. Stawicki discloses a golf swing-training device with shoulder straps (22 & 26). And, Pritchard et al. discloses a flexible pad (14) for shoulder straps (12). All these references including Cole disclose a pad that is used as a cushion between the golfer and a device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a shoulder strap and a shoulder strap pad as taught by Stawicki and Pritchard et al. as an alternative way of positioning the device at a different location of a golfer's body.

**Claims 21-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cole. These method claims appear to be directed to the obvious steps of using Lazier's golf swing device.

### ***Response to Arguments***

Applicant's arguments filed in paper no. 8 have been fully considered but they are not persuasive.

Applicant argues that the Cole patent (US Patent No. 5,919,097) neither discloses nor suggests the aid of the presently pending invention since "ones arms move independently from one's shoulders and therefore the device of the Cole does not give an indication of shoulder turn, but merely indicates the position of the arms" and "a typical back swing associated with many mid-to-high handicap golfers ...lifting only the arms". Cole for example, discusses correct swing practices in his columns 2-3. From his discussion about correct back swing, the different positions of the indicator and about proper weight transfer it is clear that the arm is not the only body part that will need to move to achieve the proper swing. If it was only the arm that moves independently from the shoulder as stated by Applicant, then the golf swing indicator of Cole would have been visible through out any swing.

Applicant argues the present invention provides a different method of indicating a correct swing while always remaining visible to the golfer, as opposed to the device of the Cole's and Lazier's patent (US Patent No. 5,785,603) that indicate a proper swing by moving out of the vision of the golfer and "in order for the device of the Cole patent to fit on the shoulder, it would need to be turned 90 degrees in order for the strap to fasten under the armpit and around the back of the shoulder. In this position, the cylindrical shaped bands could not conform to the shape of the shoulder and would stand proud of the shoulder". However, it is noted that the features upon which applicant relies (i.e., the device always remaining visible to the golfer and the device to fit on the shoulder) are not recited in the rejected claim(s). Although the claims are interpreted in light of the



specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that Stawicki (US Patent No. 5,150,901) "does not relate to a shoulder turn indicator at all". However, Stawicki is a swing-training device to be placed on the shoulder (10) and the main reason that the Stawicki's device is used in the rejection is to show that a ball (44) and socket (46) joint is common in the art of golf swing devices.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell, can be reached on (703) 308-2126. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



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